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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,158	03/19/2001	Robert L. Battey	10961158-2	2950

7590

06/17/2003

HEWLETT-PACKARD COMPANY  
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EXAMINER

NGHIEM, MICHAEL P

ART UNIT

PAPER NUMBER

2863

DATE MAILED: 06/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/812,158

Applicant(s)

BATTEY ET AL.

Examiner

Michael P Nghiem

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2863

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 16-20 and 22-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-20 and 22-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

The Amendment filed on April 11, 2003 has been acknowledged.

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 16-20 and 22-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,203,147 to Battey et al. in view of US Patent No. 6,168,262. to Clark et al..

Battey et al. claims the following claimed features of the invention:

- a replaceable ink container (claims 1-17) for use in an off axis printing system, the printing system being responsive to electrical signals produced by the replaceable ink container for controlling printing system parameters, the replaceable ink container

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having a leading edge defined as that edge of the replaceable ink container first received by the printing system, the replaceable ink container comprising:

- a plurality of electrical contacts at a first side on the leading edge, the plurality of electrical contacts configured for engaging a plurality of corresponding electrical printer contacts of the printing system (claims 1, 6, 14-17);
- a fluid outlet on the leading edge at a second side of the leading edge, wherein the first side and the second side are positioned adjacent opposite ends of the leading edge, such that the fluid outlet is separated from the plurality of electrical contacts, the fluid outlet being in fluid communication with the replaceable ink container and configured for engaging a fluid inlet of the printing system (claims 1, 6, 13-17);
- an information storage device electrically connected to the plurality of electrical contacts (claim 5);
- the leading edge defines a longitudinal axis with the first side and the second side being disposed on the longitudinal axis (claims 2, 10);
- a latch feature, the replaceable ink container having an unlatched position and a latched position, wherein the latch feature is in engagement with corresponding engagement features of the printing system, the plurality of electrical contacts of the replaceable ink container are in engagement with the plurality of corresponding electrical printer contacts, and the fluid outlet is in fluid communication with the fluid inlet of the printing system (claims 3, 12, 15, 17);
- the latch feature is a pair of latch features, and wherein one latch feature of the pair of latch features is on the replaceable ink container adjacent to the first side and

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another latch feature of the pair of latch features is on the replaceable ink container adjacent to the second side (claims 4).

Even though Battey et al. does not claim that the plurality of electrical contacts are located at a first half on the leading edge and the fluid outlet is on a second half of the leading edge, it would have been obvious to modify the locations of the electrical contacts and the fluid outlet such that the electrical contacts are on one half and the fluid outlet is on the other half of the leading edge as disclosed by Clark et al. (Fig. 3c) for the purpose of separating the electrical contacts from the fluid outlet and minimizing the chance of ink leakage from the fluid outlet contaminating the electrical contacts (column 5, lines 58-61).

### ***Response to Arguments***

2. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### ***Contact Information***

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Nghiem whose telephone number is (703) 306-3445. The examiner can normally be reached on M-H from 6:30AM – 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached at (703) 308-3126. The fax phone numbers for

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the organization where this application or proceeding is assigned are (703) 308-7724 for regular communications and (703) 308-5841 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



**MICHAEL NGHIEM**  
**PRIMARY EXAMINER**  
Michael Nghiem

June 16, 2003